

REMARKS

The applicant acknowledges and appreciates receiving an initialed copy of the form PTO-1449 that was filed on January 21, 2004.

The office action acknowledges neither the claim of priority nor receipt of the certified copy of the priority document. Accordingly, attached hereto is a copy of:

- OIPE hand delivery filing receipt, stamped by OIPE on January 21, 2004, acknowledging receipt of items including the Japanese priority document JP2003-012084; and
- Stamped postcard receipt of January 21, 2004 acknowledging receipt of items including the Japanese priority document JP2003-012084.

A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO. Inasmuch as the above item is properly itemized on the postcard receipt and the filing receipt, it is respectfully submitted that the priority document was submitted. Acknowledgment of the claim of priority and of receipt of the priority document is respectfully requested.

Claims 1 – 9 are pending. The applicant respectfully requests reconsideration and allowance of this application in view of the above amendments and the following remarks.

Claim 6 was amended to remedy a cosmetic defect.

Claims 2 – 6 were rejected under 35 USC 103(a) as being unpatentable over Japanese Patent Document No. 03-004218 (“JP ‘218”). The applicant respectfully requests that this rejection be withdrawn for the following reasons.

As described in the application, the invention recognizes the problem that an entire meter unit is exchanged even when only a part of the meter unit fails, because the failed part cannot be detached and replaced. (E.g., specification page 2, lines 15 - 22.) Independent claim 1 recites in combination, for example, “the indication part memorizes a first indication deviation data, which provides a deviation between a detected value detected by the sensor and a raw value indicated by the indication part without compensating the deviation;” “the control part memorizes a second indication deviation data of the indication part, compensates the detected value on the basis of the second indication deviation data, and controls the indication part on the basis of the compensated detected value;” and “the second indication deviation data is rewritable so that the second indication deviation data coincides with the first indication deviation data.” By using the deviation data, the indication part and the control part can be adjusted appropriately. Moreover, the control part and the indication part are separate structures but are interrelated.

Furthermore, the deviation data includes the first indication deviation data memorized in the indication part and the second indication deviation data memorized in the control part. Consequently, even if the indication part or the control part is damaged, the meter unit can be repaired by changing out only the damaged part. Because the second indication deviation data is rewritten in the control part, the indication part and the control part can be adjusted appropriately. Therefore, the meter unit can be repaired without exchanging the entire meter unit.

On the other hand, without conceding that JP ‘218 discloses any feature of the present invention, JP ‘218 is directed to a meter unit including rewritable nonvolatile memory (4) for memorizing the indicative characteristics of the meter (6).

To properly reject a claimed invention, the examiner must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness with respect to a claimed invention,

all the claim limitations must be taught or suggested by the prior art reference (or references when combined). *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Furthermore, the teaching or suggestion to make the claimed combination and a reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The examiner bears the burden of establishing this *prima facie* case. *In re Deuel*, 34 U.S.P.Q.2d 1210, 1214 (Fed. Cir. 1995). The applicant for patent may then attack the *prima facie* case as improperly made out, or present objective evidence tending to support a conclusion of nonobviousness. *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992).

Where, as here, the examiner fails to establish a *prima facie* case of obviousness, the applicant has no burden to rebut the rejection of obviousness with evidence. *In re Rijckaert*, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993). If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of patent. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

The applicant provides herein a selection of some examples of limitations in the claims which are neither taught nor suggested by JP '218.

JP '218 fails to teach or suggest the "indication part," which memorizes the first indication deviation data as further recited. Moreover, JP '218 fails to teach or suggest the "control part," which memorizes a second indication deviation data of the indication part, and controls the indication part as further recited. Furthermore, JP '218 fails to teach or suggest that

the second indication deviation data is rewritable so that the second indication deviation data coincides with the first indication deviation data.

The office action assumes that the indicative characteristics in JP '218 include deviation data, although JP '218 neither teaches nor suggests deviation data, let alone where the deviation data is memorized, functions taken based on the deviation data, or that the deviation data includes two types of data memorized in the control part and the indication part, respectively.

The final Office Action admits that JP '218 "does not specifically disclose the use of deviation data specifically." (Final Office Action, page 2.) Recognizing that JP '218 fails to teach and/or suggest the invention as claimed, the office action relies on examiner argument or personal knowledge to remedy the deficiencies.

The examiner first argues that "a meter can measure deviations in data, in and of itself, then this limitation would be obvious to one of ordinary skill in the art since most meters are used to measure some data over some period of time and therefore a 'deviation' in the data would naturally occur." Second, the examiner contends that there is a motivation to modify JP '218 because "it would be obvious for one of ordinary skill in the art to manipulate the data and compile it into some form that is useful to a user."

The examiner appears to be relying on personal knowledge to support the finding of what is known in the art. This is Official Notice, the taking of which is respectfully traversed, and the examiner is requested to provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. MPEP 2144.03 See 37 CFR 1.104(d)(2). An examiner cannot simply reach conclusions based on their own understanding, or experience, or assessment of what would be basic knowledge or common sense. Rather, there must be some concrete evidence in the record in support of these findings. *In re Zurko*, 258 F.3d 1379, 1385,

59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Moreover, the examiner's expertise "may provide sufficient support for conclusions [only] as to peripheral issues." *Id.* at 1385-86, 59 USPQ2d at 1697.

It appears that the examiner is utilizing the noticed fact to provide a motivation to modify 'JP 218, hence, the noticed fact is clearly not a peripheral issue. Accordingly, it is inappropriate for the examiner to rely on official notice, and the examiner is requested to provide the above-mentioned affidavit or declaration.

Nevertheless, the examiner's arguments fail to remedy the deficiencies in JP '218. For example, if JP '218 is modified as in the office action, and applicant vigorously denies that it can be so modified, modified JP '218 does not teach or suggest, for example, where the deviation data is memorized, functions taken based on the deviation data, or that the deviation data includes two types of data memorized in the control part and the indication part, respectively.

Hence, JP '218, even when modified as proposed, fails to teach or suggest the combination of features recited in independent claim 1, when considered as a whole.

Furthermore, JP '218 operates in a fundamentally different way than the claimed invention. Specifically, JP '218 neither teaches nor even suggests, let alone disclose, anything about storing deviation data in the indication part and the control part. Accordingly, the entire meter unit in JP '218 has to be exchanged when a part of the meter unit is damaged. The Office Action cites JP '218 as suggesting deviation data, however, JP '218 is clearly deficient considering the invention as claimed as a whole. Consequently, the proposed combination fails to teach or suggest the claimed invention.

With respect to the rejected dependent claims, the applicant respectfully submits that these claims are allowable not only by virtue of their dependency from independent claim 1, but

also because of additional features they recite in combination. In addition, the examiner appears to be taking Official Notice with respect to claims 2 – 6. For the reasons provided above, the examiner is respectfully requested to provide an affidavit or declaration setting forth specific factual statements and explanation to support the findings. MPEP 2144.03 See 37 CFR 1.104(d)(2).

New claims 7 - 9 have been added to further define the invention, and is believed to be patentable for reasons including these set out above.

The applicant respectfully submits that, as described above, the cited prior art does not teach or suggest the combination of features recited in the claims. The applicant does not concede that the cited prior art shows any element recited in the claims. However, the applicant has provided specific examples of elements in the claims that are clearly not present in the cited prior art.

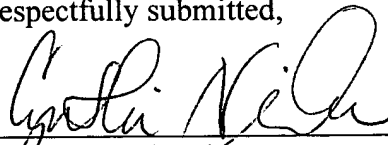
The applicant strongly emphasizes that one reviewing the prosecution history should not interpret any of the examples the applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, for the sake of simplicity, the applicant has provided examples of why the claims described above are distinguishable over the cited prior art.

In view of the foregoing, the applicant respectfully submits that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

Serial No. 10/760,485

Please charge any unforeseen fees that may be due to Deposit Account No. 50-1147.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Cynthia K. Nicholson', written over a horizontal line.

Cynthia K. Nicholson

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